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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,071	01/23/2004	Toros Kejejian		8003

7590 08/25/2006  
Stephen E. Feldman, P.C.  
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New York, NY 10017

EXAMINER

REESE, DAVID C

ART UNIT PAPER NUMBER

3677

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/764,071

Applicant(s)

KEJEJIAN, TOROS

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/3/2006 has been entered. Consequently, the following is the current listing of claims in the instant application:

#### ***Status of Claims***

- Claims 1-20 are canceled.
- Claims 21-22 were amended.
- Claims 21-40 are pending.

#### ***Claim Objections***

[1] Claim 21 is objected to because of the following informalities: "steps" in lines 11 and 13 should be "step". Appropriate correction is required.

[2] Claims 23, 30, and 35 recite the limitation "said crown" in the instant claim and dependent one therefrom (Claim 22). There is insufficient antecedent basis for this limitation in the claims.

#### ***Claim Rejections - 35 USC § 102***

[3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[4] Claim 21 is rejected under 35 U.S.C. 102(e) as being unpatentable over Namdar US-D499, 981, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Namdar is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Namdar teaches of a mixed cut gemstone (see next page) comprising:

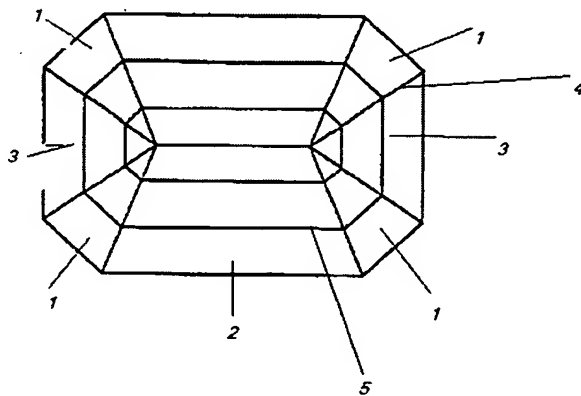
- a crown (see figures 1-4);
- a pavilion (Fig. 5);
- four lower corner facets (1), said lower corner facets being triangles (1);
- two long-side lower girdle facets (2), said long-side lower girdle facets being triangles or trapezoids (2);
- two short-side lower girdle facets (3), said short-side lower girdle facets being triangles (3);
- a plurality of step cuts (5), said step cuts being substantially equal in width; and
- a plurality of rib lines (4);

whereby said steps cuts (5) are cut at a predetermined angle with respect to said lower girdle facets (2,3) with each step (5) being at a slightly different angle, said different angle step

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cuts (5) [allowing light that passes through the crown to hit the plurality of steps cuts at different angles thereby bending the light several times in different directions thus providing the gemstone with parallel incoming and outgoing rays of light that make the gemstone appear more brilliant and scintillated].

Examiner's note: the above statement in brackets is an example of intended use. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. In the instant case, the above amendment to the claim has provided no additional structure requirements or limitations. Attempting to claim a gemstone via the way light passes through said gemstone is not proper and is not given any patentable weight over the prior art that satisfies the same structural limitations.



***Claim Rejections - 35 USC § 103***

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namdar US-D499, 981, in view of Kejejian US-6,449,985.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 22, Namdar teaches of that from Claim 21.

The difference between the claim and Namdar is the claim recites:

four upper corner facets, said upper corner facets being polygons;

two long-side upper girdle facets, said long-side girdle facets being triangles;

two-short side upper girdle facets, said short-side upper girdle facets being triangles; and

four break table lines, said break table lines separating said table from said upper corner facets;

[whereby said break table lines provide the gemstone with better dispersion and scintillation coefficients].

Kejejian discloses a mixed cut gemstone similar to that of Namdar. In addition, Kejejian further teaches a

a girdle (51);

a table (13);

four upper corner facets (15), said upper corner facets being polygons (15);

two long-side upper girdle facets (17), said long-side girdle facets being triangles (17);

two-short side upper girdle facets (17), said short-side upper girdle facets being triangles (17); and

four break table lines, said break table lines separating said table (13) from said upper corner facets (15);

[whereby said break table lines provide the gemstone with better dispersion and scintillation coefficients].

[]: Example of intended use as the statement fails to further limit the structure of the claimed invention. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

It would have been obvious to one of ordinary skill in the art, having the disclosures of Namdar and Kejejian before him at the time the invention was made, to modify the crown and table of Namdar to incorporate an embodiment (with obvious sizes changes to accompany the different size pavilion, as in Kejejian). One would have been motivated to make such a

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combination because one would want to achieve that crown and table structure, as taught by Kejejian to go along with the pavilion structure from Namdar.

Re: Claim 23, Kejejian (Claim 1).

Re: Claim 24, Kejejian discloses wherein the table (13) is flat.

Re: Claim 25, Namdar teaches wherein said lower corner facets have an inclination of approximately 40 to 50 degrees with respect to a plane of said girdle (the figures of the pavilion between the applicant and Namdar are identical).

Re: Claim 26, Namdar teaches wherein said lower corner facets (1) are isosceles triangles (1).

Re: Claim 27, Kejejian (Claim 5).

Re: Claim 28, Kejejian (Claim 6).

Re: Claim 29, Kejejian (Claim 11).

Re: Claim 30, Kejejian (Claim 12).

Re: Claim 31, Namdar teaches wherein said rib lines divide said pavilion into eight sides.

Re: Claim 32, Namdar teaches wherein said rib lines run from said girdle's eight sided shape to a culet line.

Re: Claim 33, Namdar teaches wherein said rib lines converge at a culet point.

Re: Claim 34, Kejejian discloses wherein said table is slightly elevated from the surface of a girdle plane.

Re: Claim 35, Kejejian (Claim 12).

Re: Claim 36, Kejejian (Claim 11).



Re: Claim 37, Namdar teaches wherein said pavilion has a depth of approximately one fourth of a length of said girdle (the figures of the pavilion between the applicant and Namdar are identical).

[7] Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namdar US-D499, 981, in view of Kejejian US-6,449,985, and further in view of Grossbard, US – 4,555,916.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 38, Namdar in view of Kejejian teaches of claim 22.

The difference between the claim and Namdar in view of Kejejian is the claim recites: further comprising a plurality of crown facets. Grossbard discloses a mixed cut gemstone similar to that of Namdar in view of Kejejian. In addition, Grossbard further teaches of a plurality of crown facets (19). It would have been obvious to one of ordinary skill in the art, having the disclosures of Namdar in view of Kejejian and Grossbard before him at the time the invention was made, to modify the crown of Namdar in view of Kejejian to include facets as in Grossbard. One would have been motivated to make such a combination because one would want to achieve that exact crown facet structure, as taught by Grossbard.

***Response to Arguments***

[8] Applicant's amendments and arguments filed 3/3/2006 regarding rejections under 35 U.S.C. 102 and under 35 U.S.C. 103 have been fully considered but they are not persuasive. Applicant states that the prior art does not disclose or teach of the amended subject matter added to independent claim 21. The examiner disagrees. As stated above, the amended subject matter is an example of intended use and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. In the instant case, the amendment to the claim has provided no additional structure requirements or limitations. Attempting to claim a gemstone via the way light passes through said gemstone is not proper and is not given any patentable weight over the prior art that satisfies the same structural limitations.

***Conclusion***

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**[9] THIS ACTION IS NON-FINAL**

**[10]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese  
Assistant Examiner  
Art Unit 3677

DCR



8/7/06



**ROBERT J. SANDY**  
**PRIMARY EXAMINER**